

## **REMARKS**

Claims 1-10, 12, 14-20 are pending in this application, of which claims 1, 3, 8, 10, 12, 14, 16 and 19 are in independent form. Claims 1-3, 6, 7, 10, 12, 14-16 have been amended to more clearly define what Applicant regards as his invention. Claims 11 and 13 have been cancelled and their subject matter has been incorporated into independent claims 10 and 12, respectively. Reconsideration is respectfully requested.

### **Drawings Objected To - 37 C.F.R. §1.84(p)(5)**

The Examiner objected to the drawings for failing to comply with 37 C.F.R. §1.84(p)(5) because they include reference character “H,” which was not mentioned in the description. The Examiner requested a corrected drawing sheet. Reference letter “H” has been removed from Fig. 4 and a “Replacement Sheet” is enclosed herewith. Applicant respectfully requests that this objection be withdrawn.

### **Drawings Objected To - 37 C.F.R. §1.83(a)**

The Examiner objected to the drawings under 37 C.F.R. §1.83(a) and requested that the Applicant show “at least one of the lower girdle facets being rotated such that the at least one lower girdle facet is not tangent to a circumference about the stone.” New Fig. 3A, which illustrates at least one lower girdle facet being rotated, has been added and the specification has been amended accordingly. Support for Fig. 3A is found at least in paragraph 27 of the specification as originally filed. Thus, no new matter has been added. Applicant respectfully requests that this objection be withdrawn.

### **Claim Rejection - 35 U.S.C. §112**

Claims 8, 9, 19 and 20 were rejected under 35 U.S.C. §112 for failure to comply with the enablement requirement. The Examiner stated that the claims contained subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Applicant has added Fig. 3A to show how at least one lower girdle facet is rotated so that the at least one lower girdle facet is not tangent to a circumference about the stone. Applicant has amended the specification accordingly. Support for Fig. 3A is found at least in paragraph 27 of the specification as originally filed. Thus, no new matter has been added to the application. Applicant respectfully requests that this rejection be withdrawn.

### **Claim Rejections - 35 U.S.C. §102(b)**

Claims 1, 2 and 10-15 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Nos. D141,259 to Fine (“the Fine ‘259 patent) and D204,199 to Westreich (“the Westreich ‘199 patent”). Applicant has amended claims 1, 10, 12 and 14 to more clearly define Applicant’s invention. Claims 1, 10, 12 and 14 now recite a stone having three upper girdle facets having a common vertex and three lower girdle facets where only two lower girdle facets have a common vertex. Support for the additional features recited in claims 1, 10, 12 and 14 can be found at least in paragraphs 23-25 and 27 (Figs. 1-3) of the specification as originally filed.

Applicant respectfully submits that the Fine ‘259 patent and the Westreich ‘199 patent do not teach or suggest all of the limitations of claims 1, 10, 12 and 14. Specifically, there is no teaching or suggestion in either the Fine ‘259 patent or the Westreich ‘199 patent of a stone having three upper girdle facets having a common vertex as well as three lower girdle facets where only two lower girdle facets have a common vertex.

As all the features recited in independent claims 1, 10, 12 and 14, as amended, are not taught or suggested by the Fine '259 patent and the Westreich '199 patent, Applicant submits that these claims are allowable over the Fine '259 patent and the Westreich '199 patent. Dependent claims 2 and 15 depend from independent claims 1 and 14, respectively, and are allowable for at least the same reasons as discussed above in connection with claims 1 and 14.

Claims 8, 9, 19 and 20 were rejected under 35 U.S.C. § 102(b) as being anticipated by the Fine '259 patent and the Westreich '199 patent. Applicant has amended the drawings to include new Fig. 3A, which illustrates a lower girdle facet being rotated.

Applicant respectfully submits that the Fine '259 patent and the Westreich '199 patent do not teach or suggest all of the limitations of claims 8 and 19. The Examiner states in the Office Action at pages 5, 6 and 8 that Figs. 1-3 of the Fine '259 patent and the Westreich '199 patent disclose that at least one of the lower girdle facets is rotated so that the at least one lower girdle facet is not tangent to a circumference about the stone. Moreover, the Examiner states in the Office Action at pages 7 and 10 that Figs. 1-3 of the Fine '259 patent and the Westreich '199 patent disclose a method of forming a lower girdle facet on the pavilion portion rotated to not be tangent to a general circumference of the stone. As understood by Applicant, however, Figs. 1-3 of the Fine '259 patent and the Westreich '199 show non-rotated lower girdle facets. Therefore, Applicant submits that the Fine '259 patent and the Westreich '199 patent do not teach or suggest at least one rotated lower girdle facet as shown in Fig. 3A and described in the specification (see Specification, Paragraph 29). Accordingly, claims 8 and 19 are believed to be patentable over the Fine '259 patent and the Westreich '199 patent.

As all the features recited in independent claims 8 and 19 are not taught or suggested by the Fine ‘259 patent and the Westreich ‘199 patent, Applicant submits that these claims are allowable over the Fine ‘259 patent and the Westreich ‘199 patent. Dependent claims 9 and 20 depend from independent claims 8 and 19, respectively, and are allowable for at least the same reasons as discussed above in connection with claims 8 and 19.

### **Claim Rejections - 35 U.S.C. §102**

Claims 3-7 and 16-18 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,713,219 to Itzkowitz (“the Itzkowitz ‘219 patent”). Claims 3-5, 7 and 16-18 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. D437,671 to Fajerstein (“the Fajerstein ‘671 patent”). Claims 3-6 and 16-18 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,668,585 to Markowitz (“the Markowitz ‘585 patent”). Applicant has amended claims 3 and 16 to define more clearly what Applicant regards as his invention. Claims 3 and 16 now recite “wherein the stone is a round cut.” Support for this additional feature can be found in the specification as originally filed, at least at paragraph 40, as shown in Fig. 7.

Applicant respectfully submits that the Itzkowitz ‘219, Fajerstein ‘671 and Markowitz ‘585 patents do not teach or suggest all of the limitations of claims 3 and 16. Specifically, there is no teaching or suggestion in the Itzkowitz ‘219, Fajerstein ‘671 and Markowitz ‘585 patents of a round cut stone, which has pavilion facets varying in width.

As all the features recited in independent claim 3 and 16, as amended, are not taught or suggested by the Itzkowitz ‘219, Fajerstein ‘671 and Markowitz ‘585 patents, Applicant submits that these claims are allowable over the Itzkowitz ‘219, Fajerstein ‘671 and Markowitz ‘585 patents. Dependent claims 4-7, 17 and 18 depend from independent claims 3 and 16, respectively, and are allowable for at least the same reasons as discussed above in connection with claims 3 and 16.

In light of Applicant's amendments and remarks, a notice of allowance is respectfully requested. Should the examiner have any questions or concerns regarding this amendment or the above-identified application, then a telephonic interview with the undersigned is respectfully requested to discuss any such questions or concerns and to accelerate the allowance of the above-identified application.

No fee is believed due for this submission. However, should any fee be required, please charge all such fees to Jones Day Deposit Account No. 503013.

Date: January 28, 2005

Respectfully submitted,

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Attachments: 1 Replacement Sheet (Fig. 4)

1 New Sheet (Fig. 3A)

**AMENDMENTS TO THE DRAWINGS:**

The attached Replacement Sheet includes changes to Fig. 4. The reference letter "H" has been deleted from Fig. 4. Please replace the original drawing sheet with the Replacement Sheet attached hereto. A New Sheet containing Fig. 3A, which illustrates a lower girdle facet being rotated, has been provided. No new matter has been added to the application.

Approval of the drawing sheets is respectfully requested.